

REMARKS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the remarks and amendments herein. The Examiner is thanked for withdrawing the rejections under §112, second paragraph, and under §§ 102(b) and 103.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-14 and 18-53 are now pending, and claims 14, 18-26, and 52-53 are under examination. Claims 14, 18, 20, 22, 23, 26, 52 and 53 have been amended, without prejudice, without admission, without surrender of subject matter, and without any intention of creating any estoppel as to equivalents.

No new matter is added.

It is submitted that these claims are and were in full compliance with the requirements of 35 U.S.C §112. In addition, the amendment and remarks herein are not made for the purpose of patentability within the meaning of 35 U.S.C. §§101, 102, 103 or 112; but rather the amendments and remarks herein are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. PRIORITY

The Office Action indicated that no certified copy of the priority document had been filed as of the date of the Office Action. Applicants respectfully submit that a certified copy of GB 0107383.2 filed March 23, 2001 and of PCT/GB2002/001457 filed March 25, 2002 were provided to the Patent Office on September 15, 2008.

Thus, Applicants respectfully submit that the requirements for priority have been satisfied. Acknowledgement of the claims of priority is respectfully requested.

III. THE REJECTIONS UNDER 35 U.S.C. §112 ARE OVERCOME

Claim 53 was rejected under 35 U.S.C. §112, first paragraph, because the specification is allegedly not enabled for prevention of the production of the 11 β -HSD1 protein. Applicants respectfully traverse.

Although Applicants believe the specification is fully enabling for claim 53 as previously presented, claim 53 has been amended herein to remove the term “prevent”. Accordingly, the rejection is now moot.

Claim 18 was rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Applicants respectfully traverse.

Specifically, the reference to Table IV of *Monder and White* was considered to render the claim indefinite as the claim allegedly does not stand alone. Claim 18 has been amended herein to remove the reference to *Monder*, and to insert the specific steroids. Support for this amendment can be found in the specification as filed at page 24, lines 8-10. Applicants respectfully submit that this amendment renders the rejection moot.

Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. §112, second paragraph, is respectfully requested.

III. THE ART REJECTIONS ARE OVERCOME

Claims 14, 18-23 and 52 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by *Levine et al.* (USP 5,985,861) as evidenced by *Monder et al.* Claim 53 was rejected under 35 U.S.C. §103(a) as allegedly unpatentable over *Levine et al.* as evidenced by *Monder et al.* Claims 24-25 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Levine et al.*, as evidenced by *Monder et al.*, and further in view of *Kotelevtsev et al.* Claim 26 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Levine et al.*, as evidenced by *Monder et al.*, in view of *Kotelevtsev et al.*, and further in view of *Fruchart et al.* The rejections are respectfully traversed.

Applicants respectfully remind the Examiner that a two-prong inquiry must be satisfied in order for a Section 102 rejection to stand. First, the prior art reference must contain all of the elements of the claimed invention, *see Lewmar Marine Inc. v. Barient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987), and, the single prior art reference must contain an enabling disclosure, *see Chester v. Miller*, 15 U.S.P.Q.2d 1333, 1336 (Fed. Cir. 1990).

It is respectfully submitted that the cited reference fails to disclose each and every element of the pending claims.

The Examiner is also respectfully reminded of the case law as to obviousness, namely, that there must be some prior art teaching which would have provided the necessary incentive or motivation for modifying the reference teachings. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (BOPAI 1993). Further still, “obvious to try” is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). And, as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): “The mere fact that the prior art may be modified in the manner suggested by the Office Action does not make the modification obvious unless the prior art suggests the desirability of the modification.”

Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Furthermore, it has recently been reaffirmed by the Supreme Court in *KSR* that the factors set out in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18: “[T]he scope and content of the prior art are determined; differences between the prior art and the claims at issue are...ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *KSR International Co. v. Teleflex Inc.*, 550 U.S. ____ (2007).

The obviousness rejections combine Levine et al., with Monder et al., additionally in combination with Kotelevtsev et al. and Fruchart et al. for some claims. Applicants respectfully submit that none of these references, either alone or in any combination thereof teach or suggest the claimed invention.

The present claims relate to a method for reducing cardiovascular disease risk in an animal at risk of cardiovascular disease, comprising administering to said animal a pharmaceutically effective amount of an agent which directly inhibits 11 β -HSD1 protein synthesis or 11 β -HSD1 reductase activity. That is, the present claims relate to a method that requires that the agent inhibits 11 β -HSD1 at the protein level, i.e. either by inhibiting production of the protein from mRNA or by directly inhibiting the 11 β -HSD1 reductase activity of the

enzyme itself. Applicants respectfully submit that none of the cited references teach or suggest such a method.

Turning to Levine, which reference is used in all of the art rejections, the Office Action alleges that Levine relates “a method of treating or reducing ischemia or the incidence of cardiovascular events or treating coronary artery disease comprising the administration of progesterone”. Office Action at 7. The Office Action uses Monder to further describe the progesterone used in Levine as an inhibitor of 11 β -HSD1 activity.

However, Monder describes progesterone of inhibiting the oxidative (dehydrogenase) activity of 11 β -HSD1 (i.e., 11-OH to 11-oxo), as shown by the heading “(a) Oxidation (11-OH to 11-oxo)” at the top of Table IV in Monder, under which heading progesterone is listed.

In contrast, the pending claims are now directed to inhibitors of 11 β -HSD1 reductase activity, which excludes progesterone.

Thus, the Section 102(b) rejections must be withdrawn as the cited references fail to teach each and every element of the claims, namely by failing to teach to inhibitors of 11 β -HSD1 reductase activity.

Further, the Section 103(a) rejections also fail as neither Monder or Levine teach or suggest administration of an inhibitor of 11 β -HSD1 reductase activity in the treatment of cardiovascular disease, and nothing in Kotelevtsev et al. or Fruchart et al. remedies this deficiency. Indeed, as evidenced by Monder, if one of skill in the art were to follow the teaching of Levine and administer progesterone to a subject, the result would be an inhibition of the dehydrogenase activity of 11 β -HSD1. This would prevent the inactivation of cortisol to cortisone and result in an increase in local cortisol concentrations.

The present invention relates to the exact opposite; the present invention teaches that by inhibiting 11 β -HSD1 reductase activity, a reduction in cortisol can be achieved. Thus, there is no teaching, suggestion or motivation in any of Levine, Monder, Kotelevtsev et al. or Fruchart et al. to administer an inhibitor of 11 β -HSD1 reductase activity, as is required by the claims as amended herein.

As none of the cited references teach each and every element of the claims, nor do any of the cited references provide any suggestion, motivation, or teaching that would direct one of skill in the art to the claimed method, and as any such combination of the references would not arrive at the claimed method, the rejections under Sections 102 and 103 cannot stand. Reconsideration

and withdrawal of the rejections under 35 U.S.C. §§ 102 and 103 is therefore respectfully requested.

REQUEST FOR INTERVIEW

If any issue remains an impediment to allowance, a further interview with the Examiner is respectfully requested and the Examiner is additionally requested to contact the undersigned to arrange a mutually convenient time and manner for such an interview.

CONCLUSION

Favorable reconsideration of the application as amended herein and prompt issuance of a Notice of Allowance, or an interview at a very early date with a view to placing the application in condition for allowance, are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date.

Respectfully submitted,

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